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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,729	01/28/2004	Jesse D. Crum	WK/2004-05/US	3435

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EXAMINER
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RESAN, STEVAN A

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/766,729

Applicant(s)

CRUM, JESSE D.

Examiner

Stevan A. Resan

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 17-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10-4-2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**1. Restriction to one of the following inventions is required under 35 U.S.C. 121:**

- I. Claims 1-16, drawn to a magnetic laminate, classified in class 428, subclass 692.1.**
- II. Claims 17-21, drawn to a method, classified in class 83, subclass 39+.**
- III. Claims 22-27, drawn to a business method, classified in class 705, subclass 500+**

**2. The inventions are distinct, each from the other because:**

**3. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed may be made by another and materially different process such as using knife cutting rather than die cutting.**

**4. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the the process for using the product as claimed can be practiced with another materially different product such as one in which the magnetic force is produced after imaging.**

5. .Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Michael Maieron May 5, 2005 a provisional election was made without traverse to prosecute the invention of I , claims 1-16.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 17-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said first sheet" in line 8. There is insufficient antecedent basis for this limitation in the claim. Furthermore it is unclear to what "a first dimension", "a second dimension" and "a third dimension" refers. Are these dimensions from edges?

Claim 3 recites the limitation "similar dimensions" in line 2. The word similar is deemed indefinite since the extent of similarity is not set forth.

**Claim 6 recites the limitation "said coating with said release layer" in lines 2-3.**

**There is insufficient antecedent basis for this limitation in the claim.**

**Claim 8 recites the limitation "said magnetic layer" and a "ratio" in lines 1-2.**

**There is insufficient antecedent basis for this limitation in the claim and no indication of the property to which "ratio" refers..**

**Claim 9 recites the limitation "magnetic poles" in line 1. There is insufficient antecedent basis for this limitation in the claim.**

**Claim 10 recites the limitation "said first layer" in line 6 and line 7. There is insufficient antecedent basis for this limitation in the claim.**

**Claims 2, 4, 5, 7, 11-16 are rejected for depending from a claim rejected under 35USC 112.**

**9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

**10. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin US 5458282 in view of Newman et al US 3658567.**

**Martin discloses the claimed structure of claim 1 (See Fig 16) Col 5 line 7 Col 6 line 21, except that the release layer is provided with a frangible bond.**

However Martin teaches that the magnetic layer is “adhesively secured”. It would have been obvious to one of ordinary skill in the art to use any of a number of equivalent adhesives to find the optimum adhesion strength. Newman et al is provided for teaching one of such equivalent adhesives.

Substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency.

In re Fount 213 USPQ 532 (CCPA 1982); In re Siebentritt 152 USPQ 618 (CCPA 1967); Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co. 85 USPQ 328 (USSC 1950).

It has been held that where claimed and prior art products are identical or substantially identical in structure or in composition, or are produced by identical or substantially identical processes a case of anticipation or a prima facie case of obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess the characteristic of a claimed product whether the rejection is based upon “inherency” under 35 USC 102 or on “prima facie obviousness” under 35 USC 103 jointly or alternately. In re Best 562 F2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); In re Ludke, 58 CCPA 1159, 441 F 2d at 212-13, 169 USPQ 563 (1971); In re Brown, 59 CCPA 1036, 459 F. 2d 531, 173 USPQ 685 (1972).

“ When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not”. In re Spada. 911 F2d 705, 709, 15 USPQ 2d 1655 (Fed. Cir. 1990).

With respect to stacking of the layers, it would have been obvious to one of ordinary skill in the art to stack layers for packaging and/or shipping and to place spacer sheets of sufficient thickness to diminish any negative effects of the magnetizable forces between successive layers. Likewise it would have been obvious to one of ordinary skill in the art to regulate the thickness and/or magnetic force to optimize magnetic attraction of the article to a vertical ferromagnetic surface to remain in place.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (571) 272-1513. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Carol Chaney, can be reached on (571) 272-1285.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

  
STEVAN A. RESAN  
PRIMARY EXAMINER